

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KATSUMI OISHI

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Appeal No. 96-2190  
Application 08/287,758<sup>1</sup>

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ON BRIEF

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Before KRASS, HECKER and LALL, Administrative Patent Judges.  
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 14, all of the claims in the case.

The disclosed invention relates to a time recorder which

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<sup>1</sup> Application for patent filed August 9, 1994. According to appellant, the application is a continuation of Application 07/985,783, filed December 4, 1992, now abandoned.

can be used for flexitime. A time counting circuit counts current time and calendar information. An input keypad is used to input the number of hours which must be worked within a determined period, for example a month. A control circuit comprising a CPU, ROM, RAM, etc., generates data of the remaining required work hours that an employee must work in the determined period as the employee works different hours during the determined period. This is calculated by subtracting the completed work hours within the determined period from the required work hours.

Representative claim 1 is reproduced as follows:

1. A time recorder comprising:

setting means for setting required work hours which must be worked by an employee within a determined period which is greater than one day;

output means for determining remaining required work hours to be worked by said employee within said determined period by subtracting finished work hours worked within said determined period from said required work hours; and

informing means for:

providing an indication of said remaining required work hours in said determined period, and

providing an indication of any overtime hours worked which is greater than said set required work hours in said determined period.

Appeal No. 96-2190  
Application 08/287,758

The references relied on by the examiner are:

Chalker, Jr. et al.(Chalker)	4,323,771	Apr.
6,1982		
Admitted Prior Art(APA).		

Claims 1 through 14 stand rejected under 35 U.S.C. § 103.  
As evidence of obviousness, the Examiner uses APA and offers  
Chalker to modify APA [answer, page 2 and 3].

Reference is made to Appellant's brief and the Examiner's answer for their respective positions.

**OPINION**

We have carefully considered the entire record<sup>2</sup> before us, and we will reverse the obviousness rejection of claims 1

2 The record is confusing. It contains no reply brief and supplemental notice of allowability (SNA) indicating the allowance of any of the claims. The Examiner has used the SNA form as an attachment to the Examiner's Answer [paper no. 19] to raise a point relating to the information disclosure (IDS)(paper no. 18). The Examiner then uses, in paper no. 21, the term "reply brief" to identify the Appellant's letter [paper no. 20] which merely clarified the Examiner's point relating to the IDS but did not contain any further arguments regarding the issues on appeal.

Appeal No. 96-2190  
Application 08/287,758

through 14.

The Examiner has failed to set forth a prima facie case of obviousness. It is the burden of the Examiner to establish why

one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the art, or by implications contained in such teachings or suggestions. In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." Para-Ordnance Mfg. v. SGS Importer Int'l, Inc., 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 117 S.Ct. 80 (1996), citing W. L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

At the outset, we note that claims 1 through 14 stand or

Appeal No. 96-2190  
Application 08/287,758

fall together [brief, page 8]. We take claim 1 as representative.

Appellant argues against the Examiner's interpretation of the APA in the final rejection of claim 1. The Examiner in the final rejection states that "the admitted prior art of the disclosure teaches all features claimed except for the specific time frame and the differing types of data presented." [Answer, page 2].

The Examiner then asserts that "The calculation of the overtime and even the time remaining can and is done by hand." (Answer, page 2). Appellant argues that the Examiner has not shown where and how the APA teaches this calculation [brief, page 13]. The Examiner points to the second paragraph on page 1 of the specification for this admission (APA). However, we find that the identified part of the specification is not a part of the prior art. The identified paragraph, i.e., "When, ... , then each employee must take a troublesome calculation to confirm ... remaining required working hours within the determined period." [Specification, page 1], is misinterpreted

by the Examiner. The paragraph is not a statement of what was actually being practiced before the invention was made, rather, the paragraph states that if one were to ascertain the required number of working hours, then one would have to perform this calculation by hand. Thus, we conclude that the APA does not teach the calculation by hand of the remaining required working hours during a determined period as hours are being worked on various days during the determined period. Therefore, the obviousness rejection based on the APA is flawed. However, we further consider below the section 103 rejection as presented in the record.

Appellant argues that neither the APA nor Chalker shows a "determined period" [claim 1, lines 3, 7, and 14] to be greater than one day. [Brief, pages 10 to 12]. The Examiner states that Chalker discloses a display which shows the "hours remaining necessary to complete a work tour." The Examiner alleges that this is a teaching of a general nature and would include variable times such as 40 hours per week or 150 hours per month. [Answer, page 3]. We do not agree with the Examiner. Chalker clearly points out that the tour of duty is

one day, and the clock out time is projected for that designated date. [Column 5, lines 18 through 34]. The Examiner has not pointed out any specific place in Chalker where it is contemplated to perform the calculation for keeping track of the remaining work hours during a determined period of greater than one day. We are also unable to so find. We believe that Chalker's system is indeed quite sophisticated and is probably capable of accomplishing what Appellant is doing, but we would be speculating if we so construed it. The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the

desirability of the modification." In re Fitch, 972 F.2d 1260, 1266, n.14, 23 USPQ2d 1780, 1783-1784, n.14 (Fed. Cir. 1992), citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of

Appeal No. 96-2190  
Application 08/287,758

the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, Inc., 73 F.3d at 1087, 37 USPQ2d at 1239, citing W. L. Gore & Assocs., v. Garlock, Inc., 721 F.2d at 1553, 220 USPQ at 312-313.

Therefore, we conclude that the rejection of claim 1 under 35 U.S.C. § 103 over the APA and Chalker is not sustainable. The other two independent claims, 5 and 11, contain the same limitation as claim 1, namely, a limitation relating to the inputting means for storing the "required work hours" within a "predetermined period which is greater than one day;" [claim 5, lines 3 to 5; claim 11, lines 2 to 4]. For the same rationale used for claim 1, the rejection of claims 5 and 11 is also not sustainable. Since the corresponding dependent claims 2 through 4, 6 through 10, and 12 through 14 contain at least the same limitation as discussed above, we will also reverse their rejection under 35 U.S.C. § 103 over the APA and Chalker.

#### **DECISION**

The decision of the Examiner rejecting claims 1 through



Appeal No. 96-2190  
Application 08/287,758

14 under 35 U.S.C. § 103 over APA and Chalker is reversed.

**REVERSED**

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
STUART N. HECKER	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	

Appeal No. 96-2190  
Application 08/287,758

Frank J. Jordan  
Jordan and Hamburg  
122 E. 42nd Street, Suite 3303  
New York, NY 10168

psl/ki